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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PIERRE-STEPHANE DUFOURG

Appeal 2008-2070
Application 10/606,040
Technology Center 3600

Decided: September 17, 2008

Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
MICHAEL W. O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

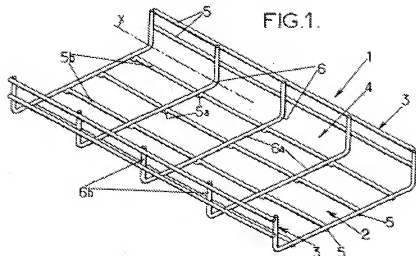
Pierre-Stephane Dufourg (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 1-6. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM.¹

THE INVENTION

The claimed invention relates to a support constructed from latticework in the form of a bracket to hold a plurality of piping or cabling. Figure 1 is representative of the subject matter on appeal. Appellant's Figure 1 is reproduced below:



Appellant's Figure 1 depicts the Appellant's claimed subject matter of a support constructed from latticework in the form of a bracket to hold a plurality of piping or cabling.

¹ Our decision will refer to Appellant's Appeal Brief ("App. Br.," filed Aug. 28, 2006), Reply Brief ("Reply Br.," filed Jan. 15, 2007), and the Examiner's Answer ("Answer," mailed Nov. 13, 2006).

THE PRIOR ART

The Examiner relies upon the following as evidence of unpatentability:

Hatch	US 1,559,695	Apr. 4, 1925
Yake	US 4,046,261	Sep. 6, 1977
Simon	US 5,531,410	Jul. 2, 1996

THE REJECTIONS

The following rejections are before us for review:

Claims 1-3 are rejected under 35 U.S.C. § 103(a) as being unpatentable over in Simon and Hatch.

Claims 4-6 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Simon, Hatch, and Yake.

The Examiner's findings to support the rejections are on pages 3 through 6 of the Answer.

Against the rejections, the Appellant presents a number of arguments.

For claims 1-3, the Appellant argues that "there is no teaching, suggestion or incentive to combine Simon and Hatch." (App. Br. 7.) The Appellant also argues that Hatch's teachings are not applicable to the concerns of the present invention. (*Id.*) The Appellant further argues that the Examiner has used hindsight. (App. Br. 8.) For claims 4-6, the Appellant argues that there "is no teaching or motivation to combine Yake with the other references and, in fact, it [Yake] teaches away from the claimed invention as the longitudinal members 4,9 are not in the same plane as the traverse members 12-20." (App. Br. 9)(emphasis original.)

In addition for claim 4, the Appellant argues that “the prior art does not teach or suggest a cable conduit having bends in a lengthwise wires having a width, measured in the first directions, that substantially corresponds to the thickness of a crosswire wire.” (App. Br. 9.)

In addition for claims 5 and 6, the Appellant argues:

the prior art does not teach or suggest a cable conduit having bends in the lengthwise wires having a width, measured in the first direction, that is greater than twice the thickness of a crosswire. ... Yake[’s] wires [] do not lie in substantially the same plane, but are offset from one another, it is respectfully submitted that there is no teaching, suggestion or motivation in the references themselves, or in the knowledge of one of ordinary skill in the art, to combine the references.

(*Id.*)(emphasis original.)

In the Reply Brief, when responding to the Examiner’s remarks on pages 7-11, the Appellant reiterates the contentions made in the Appeal Brief and offers additional ones for us to consider. The Appellant adds that it is not well known in the art to eliminate protuberances and bumps in supports composed of trellis works. (Reply. Br. 5.) The Appellant argues; however, that if it was well known to eliminate such protuberances and protrusions associated with transverse or crosswire wires in a trellis works, “the fact that there is no prior art of record that teaches the claimed subject matter ... implies that the claimed subject matter is, in fact, not obvious.” (Reply Br. 6)(emphasis original.) The Appellant argues that “as clearly shown in Figure 2, Simon actually introduces, rather than eliminates, protuberances and nodes by bending or folding the ends of the transverse wires.” (*Id.*) As such, the Appellant argues that Simon “actually teaches

away from Appellant's invention by introducing additional protuberances." (*Id.*) The Appellant additionally argues one skilled in the art "would not have considered placing bends in the longitudinal wires at the time of the present invention because, when the latticework trunking is placed on the ground or other flat surface, it decreases the contact area with the surface in which the latticework trunking rests." (*Id.*) The Appellant further argues that one skilled in the art would not look to the teaching of Hatch to modify Simon to get the claimed subject matter because Hatch is directed to a bottle carrier and the present invention is directed to flexible objects rather than rigid objects. (Reply Br. 7.) The Appellant also argues that Hatch and Yake are non-analogous art, thus no motivation to combine them with Simon. (Reply Br. 8.)

The Appellant argues claims 1-3 as a group. We select claim 1 as representative of this group. Claims 2 and 3 will stand or fall with claim 1. The Appellant argues claim 4 separately. The Appellant argues claims 5-6 as a group. We select claim 5 as representative of this group. Claim 6 will stand or fall with claim 5. 37 C.F.R. § 41.37(c)(1)(vii) (2007).

ISSUES

The first issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 1-3 under 35 U.S.C. § 103(a) as being unpatentable over Simon and Hatch. The second issue before us is whether the Appellant has shown that the Examiner erred in rejecting claims 4-6 under 35 U.S.C. § 103(a) as being unpatentable over Simon, Hatch, and

Yake. Both issues turn on whether the Appellant has shown error in the Examiner's prima facie case of obviousness.

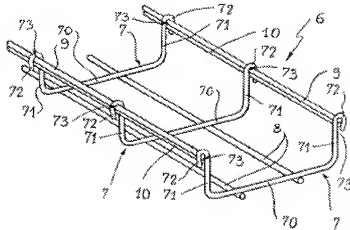
FINDINGS OF FACT

We find that the following enumerated findings of fact are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

Scope and content of the prior art

1. Figure 1 of Simon describes a trelliswork constructed from a plurality of lengthwise wires and crosswise wires.

Simon's Figure 1 is reproduced below:



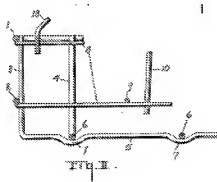
Simon's Figure 1 is said to depict a trelliswork constructed from plurality of lengthwise wires and crosswise wires.

2. The Appellant does not dispute Simon describes a trelliswork that substantially encompasses the claimed limitations of claim 1 less the

bends in the lengthwise wires that are designed to accommodate the base portions of the crosswise wires such that the longitudinal portions of the lengthwise wire lie at substantially the same level as the crosswise wires.

3. Hatch describes, in a support structure for bottles, bends in the latticework's (trelliswork's) wires to accommodate the diameter of the wires perpendicular to the wires that have the bend in them in order to permit the bottles to lay flat on the bottom latticework' wires. Hatch's Figure 2 shows this feature.

Hatch's Figure 2 is reproduced below:



Hatch's Figure 2 is said to depict the features of a latticework's wires bend to accommodate the diameter of wire perpendicular to the wires that have the bend in them.

4. Yake teaches in the bottom of a latticework (trelliswork) support structure transversing wires 12-20 having a bend width greater than twice the width of the wires 4 and 9 that rests in the bend. (Yake, Figs. 1 and 3.)

Differences between the claimed subject matter and the prior art

5. The claimed invention combines elements separately disclosed in the Simon, Hatch, and Yake.

PRINCIPLES OF LAW

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). See also *KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [Graham] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

For claims 1-3

The Examiner finds the combination of Simon and Hatch describes the elements of claim 1 and states a reason to combine Simon and Hatch.

(Answer 3-5.) We find likewise that the combination of Simon and Hatch describes the elements of claim 1. (Facts 1-3.) We also find the Examiner has articulated an apparent reason with logical underpinning for combining Simon and Hatch.

In our view, the difference between the claimed invention and the combination of Simon and Hatch is that the claimed invention combines the elements separately disclosed in Simon and Hatch. (Fact 5.) Accordingly, the elements of claim 1 appear to be a combination of elements described in Simon and Hatch. We see no unpredictable results from combining these prior art elements and the Appellant has not come forward with sufficient evidence showing the combination to yield a result that would have been unpredictable to one of ordinary skill in the art. Under these circumstances, the combination would have been obvious. See *KSR* at 1740 (“Finally, in *Sakraida v. Ag Pro, Inc.*, 425 U.S. 273, 96 S. Ct. 1532, 47 L.Ed.2d 784 (1976), the Court derived from the precedents the conclusion that when a patent “simply arranges old elements with each performing the same function it had been known to perform” and yields no more than one would expect from such an arrangement, the combination is obvious. *Id.*, at 282, 96 S.Ct. 1532.”)

Concluding the establishment of a *prima facie* case of obviousness by the Examiner, we turn now to the Appellant arguments against the *prima facie* case of obviousness.

We are not persuaded by the Appellant’s arguments there is no motivation to combine Simon and Hatch and accordingly the Examiner has used hindsight to combine. (App. Br. 7-8.) The Examiner stated a

motivation to combine Simon and Hatch: so items may lie flat on both lengthwise and crosswise wires of the trelliswork “as taught to be desirable by Hatch” (Answer 5). In our view, this is ample motivation to combine Simon and Hatch without resorting to hindsight. In addition, there is nothing in Simon or Hatch that would discourage a person of ordinary skill in the art from providing bends on the lengthwise wires to accommodate the crosswires.

We are not persuaded by the Appellant’s arguments: 1) that Hatch’s teachings are not applicable to the concerns of the present invention (App. Br. 7), or 2) that that one skilled in the art would not look to the teaching of Hatch to modify Simon to get the claimed subject matter because Hatch is directed to a bottle carrier and the present invention is directed to flexible objects rather than rigid objects (Reply Br. 7). We understand these arguments to mean that Hatch’s teachings are not directed to same problems the Appellant is trying to solve. However, the Appellant is focusing the problem to be solved too narrowly in order to show an error in the Examiner’s prima facie case of obviousness. The problem to be solved is how to make items stored in trelliswork to lay flat; not just to make cables stored in trelliswork lay flat as Appellant argues. To this end, Hatch teachings a solution to the problem of making items stored in a trelliswork lay flat: provide bends in the crosswires. Accordingly, Hatch’s teachings are applicable to the concerns of the Appellant’s invention and one of ordinary skill in the art would look to Hatch’s teachings to try to solve the problem of making items stored in a trelliswork lay flat.

We are not persuaded by the Appellant’s arguments: 1) that it is not well known in the art to eliminate protuberances and bumps in supports

composed of trellis works (Reply Br. 5), and 2) that one skilled in the art “would not have considered placing bends in the longitudinal wires at the time of the present invention because, when the latticework trunking is placed on the ground or other flat surface, it decreases the contact area with the surface in which the latticework trunking rests” (Reply Br. 6). The Appellant has not provided evidence that to one of ordinary skill in the art it is not well known to eliminate protuberances and bumps in supports composed of trelliswork or that one of ordinary skill in the art would not have considered placing bends on lengthwise wires. Appellant’s attorney’s arguments in a brief do not take the place of evidence in the record. *In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984); *Meitzner v. Mindick*, 549 F.2d 775 (CCPA 1977), *cert. denied*, 434 US 854 (1977), and *In re Schulze*, 346 F.2d 600, 602 (1965). Moreover, the evidence in the record supports the opposite positions. Hatch is a support for bottles and the support is composed of trelliswork (latticework). Hatch also places the bends on the lengthwise wires.

We are not persuaded by the Appellant’s contention that because no one piece of prior art teaches the claimed combination of elements in claim 1, then the claimed subject matter is obvious. (Reply Br. 6.) The rejection is based on a combination of references and one cannot prove unobviousness by arguing that one reference does not teach the claimed subject matter.

We also are not persuaded by the Appellant’s contention that Simon teaches away from the invention. (Reply Br. 6.) The Appellant directs our attention to Simon’s Figure 2 to support this contention. Simon’s Figure 2 is directed to the prior art. (Simon, col. 2, ll. 22-32.) Simon’s Figure 3 is

directed to Simon's invention that the Examiner used to reject the claim. (Answer 3.) As such, the Appellant is not viewing the portion of the reference the Examiner used in making the rejection.

Accordingly, we will sustain the Examiner's rejection of claims 1-3.

Claim 4

Claim 4 depends from claim 1. The Examiner finds Yake teaches a bend width greater than twice the width of the wire that runs across the bend and provides a reason to combine Yake with Simon and Hatch. (Answer 5-6.) We likewise find Yake teaches a bend width greater than twice the width of the wire that runs across the bend. (Fact 4.) We also find that the Examiner has articulated an apparent reason with logical underpinning for combining Yake with Simon and Hatch.

Concluding the establishment of a *prima facie* case of obviousness by the Examiner, we turn now to the Appellant arguments against the *prima facie* case of obviousness.

In addition to our reason *supra* with respect to claim 1, we are not persuaded by the Appellant's arguments that there "is no teaching or motivation to combine Yake with the other references and, in fact, it [Yake] teaches away from the claimed invention as the longitudinal members 4, 9 are not in the same plane as the traverse members 12-20" (App. Br. 9)(emphasis original) and that Hatch and Yake are non-analogous art, thus no motivation to combine them with Simon (Reply Br. 8). The Examiner has articulated a reason to combine Simon and Hatch with Yake: to facilitate stability (Answer 5). *KSR* only requires the Examiner to articulate an apparent reason with logical underpinning for modifying the Simon and

Hatch with Yake. *KSR* at 1740-41. In our view, The Examiner has articulated an apparent reason to combine Simon and Hatch with Yake. In addition, there is nothing in Simon, Hatch, or Yake that would discourage a person of ordinary skill in the art from providing bends on the lengthwise wires twice the width of the crosswires.

In addition, we are not persuaded by the Appellant's contention that the prior art does not suggest a cable conduit having bends in lengthwise wires whereby these bends correspond to the thickness of the crosswires. (App. Br. 9.) The rejection is based on a combination of references and one cannot prove unobviousness by arguing that one reference does not teach the claimed subject matter.

Accordingly, we will sustain the Examiner's rejection of claim 4.

Claims 5 and 6

Claim 5 depends from claim 1 and the Examiner found Yake teaches providing the bends in the lengthwise wires have a width greater than twice the thickness of the crosswire wires and provides a reason to combine Yake with Simon and Hatch. (Answer 5-6.) We agree with the Examiner finding. (Fact 4.) We also find that the Examiner has articulated an apparent reason with logical underpinning for combining Yake with Simon and Hatch.

Concluding the establishment of a *prima facie* case of obviousness by the Examiner, we turn now to the Appellant arguments against the *prima facie* case of obviousness.

In addition to our reasons *supra* with respect to claims 1 and 4, we are not persuaded that Yake's wires not laying in substantially the same plane shows an error in the Examiner's rejection. (See App. Br. 9.) While it is true

that Yake's lengthwise wires do not lie in substantially the same plane, a limitation of "substantially the same plane" is not claimed. As such, the argument is not commensurate in scope to what is claimed and the argument argues Yake individually instead of what the combination of Simon, Hatch, and Yake teach to one skilled in the art.

Accordingly, we will sustain the Examiner's rejection of claims 5 and 6.

CONCLUSIONS OF LAW

We conclude that the Appellant has not shown that the Examiner erred in rejecting claims 1-3 as being unpatentable over Simon and Hatch.

We conclude that the Appellant has not shown that the Examiner erred in rejecting claims 4-6 as being unpatentable over Simon, Hatch, and Yake.

DECISION

The Examiner's decision to reject claims 1-3 as being unpatentable over Simon and Hatch is affirmed.

The Examiner's decision to reject claims 4-6 as being unpatentable over Simon, Hatch, and Yake is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

Appeal 2008-2070
Application 10/606,040

JRG

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